

REMARKS/ARGUMENTS

This paper is submitted in response to the Office Action dated November 20, 2006. At that time, claims 1, 5-8, 10, 11, 14-16, 20-22, 24-31, 34-38, 40, 42, and 43 were pending in the application. Claims 2-4, 9, 17-19, 23, 32, 33, and 39 had previously been withdrawn prior restriction requirement. In the Office Action, claims 1, 5, 8, 10, 11, 15, 31, 34, 35, 38, 40, 42, and 43 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,533,748 issued to Wirt et al. (hereafter “Wirt”). Claims 16, 20, 22, 25, and 28 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,443,484 issued to Anglsperger (hereinafter “Anglsperger”). Claims 6-7 and 36-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wirt in view of in view of U.S. Patent No. 5,172,932 issued to Watanabe et al. (hereinafter “Watanabe”). Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglsperger in view of Watanabe. Claims 24 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglsperger in view of Wirt. Claims 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglsperger in view of U.S. Patent No. 5,961,143 issued to Hlywka et al. (hereafter “Hlywka”). Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wirt in view of U.S. Patent No. 6,003,895 issued to Niwa et al. (hereafter “Niwa”). Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglsperger in view of Niwa.

By this paper, Applicant respectfully responds to the issues raised in the Office Action. Claims 1, 16, 31, and 43 have been amended. Favorable consideration is respectfully requested.

Rejection of Claims 1, 5, 8, 10, 11, 15, 31, 34, 35, 38, 40, 42, and 43 Under § 102(b)

The Examiner rejected claims 1, 5, 8, 10, 11, 15, 31, 34, 35, 38, 40, 42, and 43 under § 102(b) as being anticipated by Wirt. This rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131 (*citing Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Id.*

(citing *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, “the reference must be enabling and describe the applicant’s claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” *In re Paulsen*, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

With respect to independent claims 1 and 31 these claims now recite that “the applique film is substantially transparent.” Similarly, claim 43 recites that “the applique film means is substantially transparent.” Support for this claim amendment is found in Applicant’s specification including page 10, lines 20-22 and page 5, lines 12-15. As explained in the specification, this claim language means that the applique film is, at least in part, transparent or translucent. *See e.g.*, specification page 10, lines 20-22. Such a claim element is not disclosed by Wirt. Rather, to the extent that the dashboard outer surface 18” of Wirt constitutes an “applique film,” there is no disclosure that this outer surface 18 is substantially transparent. Rather, the surface 18 will not let any light pass through this surface. For this reason Wirt does not disclose all of the claim elements of claims 1, 31, and 43. Accordingly, Wirt cannot anticipate these claims under § 102(b). Withdrawal of this rejection is respectfully requested.

Dependent claims 5, 8, 10, 11 and 15 depend from claim 1. Claims 34, 35, 38, 40, and 42 depend from claim 31. Accordingly, these dependent claims are likewise allowable for the same reason as put forth above in conjunction with independent claims 1 and 31. Withdrawal of these rejections is respectfully requested.

Rejection of Claims 16, 20, 22, 25, and 28 Under § 102(b)

The Examiner rejected claims 16, 20, 22, 25, and 28 under 35 U.S.C. § 102(b) as being anticipated by Anglsperger. This rejection is respectfully traversed.

As noted above, a claim cannot be rejected under § 102(b) unless each and every claim element is disclosed in the cited reference. With respect to independent claim 16, this claim recites that “the shape of the contours in the substrate corresponds to the shape of the emblem design.” Support for the element is found in Applicant’s specification including, for example, Figure 1 and page 12, lines 6-10. This element is not disclosed by Anglsperger. To the extent that Anglsperger teaches “contours” in the substrate, there is nothing in Anglsperger that

indicates that the shape of these contours correspond to the shape of the emblem design in the applique film. Accordingly, as this claim element is not disclosed in Anglsperger, this reference does not anticipate this claim under § 102(b). Withdrawal of this rejection is respectfully requested.

Dependent claims 20, 22, 25, and 28 depend from independent claim 16. Accordingly, these dependent claims are likewise allowable for the same reason as put forth above in conjunction with claim 16. Withdrawal of these rejections is respectfully requested.

Rejection of Dependent Claims 6-7, 14, and 36-37 Under 35 U.S.C § 103(a)

Claims 6-7 and 36-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wirt in view of in view of Watanabe. Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Wirt in view of Niwa. Such rejections are respectfully traversed.

The M.P.E.P. states that

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

M.P.E.P. § 2142.

Applicants respectfully submit that such dependent claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the elements in these claims. Specifically, dependent claim 6-7 and 14 depend from claim 1 while dependent 36-37 depend from independent claim 31. Accordingly, dependent claims 6-7, 14, and 36-37 all require that “the applique film is substantially transparent.” As noted above, this claim element

is not taught or suggested by Wirt. Likewise, the Watanabe and Niwa references also fail to teach or suggest this claim element. Accordingly, because the cited references fail to teach or suggest all of the elements found in dependent claims 6-7, 14, and 36-37, these references cannot be used to reject these dependent claims under § 103(a). Withdrawal of these rejections is respectfully requested.

Rejection of Dependent Claims 21, 24, 26-27, and 29-30 Under 35 U.S.C § 103(a)

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglsperger in view of Watanabe. Claims 24 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglsperger in view of Wirt. Claims 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglsperger in view of Hlywka. Claim 29 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Anglsperger in view of Niwa. Such rejections are respectfully traversed.

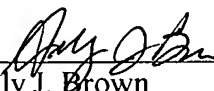
As mentioned above, a claim cannot be rejected under § 103(a) unless each of the claim elements are taught or suggested by the cited references. *See* M.P.E.P. § 2142. Claims 21, 24, 26-27, and 29-30 all depend, either directly or indirectly, from independent claim 16. Accordingly, these dependent claims all require that “the shape of the contours in the substrate corresponds to the shape of the emblem design.” As noted above, this claim element is not taught or suggested by Anglsperger. Applicant submits that Hlywka, Wirt, Watanabe, and Niwa also fail to teach or suggest this claim element. Accordingly, because the cited references fail to teach or suggest all of the elements found in dependent claims 21, 24, 26-27, and 29-30, these references cannot be used to reject these dependent claims under § 103(a). Withdrawal of these rejections is respectfully requested.

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Conclusion

Applicant respectfully submits that the pending claims are patentable over the cited references. Accordingly, Applicant requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,



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